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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,721	03/27/2001	Ronald P. Sansone	F-236	1333

919 7590 10/18/2004

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EXAMINER

VU, THONG H

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/818,721

Applicant(s)

SANSONE ET AL.

Examiner

Thong H Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/23/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. Claims 1-6 are pending.
2. Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection. Claims 1-6 have been amended. The Final action is appropriate.
3. The Cross Reference to Related Applications filed on 10/4/04 has been record.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6 are rejected under 35 U.S.C. § 103 as being unpatentable by Hilt [6,604,132 B1] in view of Oberlander et al [Oberlander 5,737,729].
5. As per claim 1, Hilt discloses a method that enables a recipient to inform a carrier (i.e.: a Web server, an Internet service provider) of the manner in which the recipient would like the mail delivered (Internet and email, col 4 lines 55-63], said method comprises the steps of:

depositing with the carrier physical mail containing the recipient's name and physical address and the sender's name and address [Hilt, a database of valid physical mailing addresses, col 8 lines 58-67; col 12 lines 49-56];

capturing the name and physical address of the recipient, and the sender from the physical mail [Hilt, name and address of recipient and sender, col 11 lines 24-45];

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translating the name and physical address of the recipient into an e-mail address [Hilt, Fig 4, the email message receiver extracted the physical mailing address data to the field of the email message, col 10 lines 8-20].

notifying the recipient of the availability of the deposited physical mail [Hilt, the server prompt a user to provide information, col 6 lines 10-20;28-34;col 7 lines 50-60;col 9 lines 10-14];

notifying the carrier of the manner in which the recipient would like the physical mail delivered [Hilt, the sender may be notified if the test violates policy, col 12 lines 49-64];

notifying the carrier that the sender does not elect the deposited physical mail to be diverted [Hilt, the source/carrier may be notified if the physical address is invalid or changed, col 12 lines 49-64]; and

However Hilt does not detail if the sender elects to permit the recipient to divert the physical mail, delivering physical mail to the recipient in the manner specified by the recipient to the carrier.

Oberlander discloses a method for message routing and destination selection wherein the user can be optionally allow to configure and determine/specify the message descriptor including a physical address [Oberlander, user optionally allow to specify the message descriptor, col 4 lines 35-col 5 line 26].

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the technique of allow user to specify the message descriptor including a physical address as taught by Oberlander into the Hilt's

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apparatus in order to utilize the control of email delivery. Doing so would provide a more effective, efficient and comprehensive way to communicate with people either by email addresses or physical mailing addresses.

6. As per claim 2, Hilt-Oberlander disclose the sender places an indication on the mail specifying that the mail should not be diverted by the recipient [Hilt, the call server request connection service eliminated the need for switch to execute a state machine to check for service logic trigger, col 6 lines 51-65].

7. As per claim 3, Hilt-Oberlander disclose charging the sender for placing an indication on the mail specifying that the mail should not be diverted by the recipient [Oberlander, user optionally allow to specify the message descriptor, col 4 lines 35-col 5 line 26].

8. As per claim 4, Hilt-Oberlander disclose the sender places an indication on the mail specifying that the mail should be delivered only as specified by the sender [Oberlander, user optionally allow to specify the message descriptor, col 4 lines 35-col 5 line 26].

9. As per claim 5, Hilt-Oberlander disclose charging the sender for placing an indication on the mail specifying that the mail should be delivered only as specified by

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the sender [Oberlander, a priority indicator indicate a particular user/sender defined, col 5 lines 1-10].

10. As per claim 6, Hilt-Oberlander disclose the recipient notifies a data center who notifies the carrier of the manner in which the recipient would like the mail delivered [Hilt, the sender may be notified, col 12 lines 49-64].

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (703)-305-4643.

The examiner can normally be reached on Monday-Thursday from 8:00AM- 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Jack Harvey*, can be reached at (703) 305-9705.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9700.

Any response to this action should be mailed to: Commissioner of Patent and Trademarks, Washington, D.C. 20231 or faxed to :

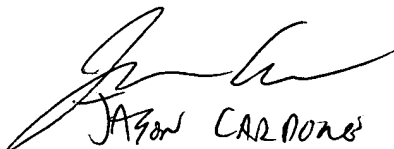
After Final (703) 746-7238

Official: (703) 746-7239

Non-Official (703) 746-7240

Hand-delivered responses should be brought to Crystal Park 11,2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

*Thong Vu*  
**Patent Examiner**  
**Art Unit 2142**



**JASON CARBONE**  
**Primary Examiner**  
**Art 2142**